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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,017	12/29/2003	Sanjoy Ganguly	S9025.0282	6508

38881 7590 06/05/2007
DICKSTEIN SHAPIRO LLP
1177 AVENUE OF THE AMERICAS 6TH AVENUE
NEW YORK, NY 10036-2714

EXAMINER

SAMALA, JAGADISHWAR RAO

ART UNIT	PAPER NUMBER
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1618

MAIL DATE	DELIVERY MODE
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06/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/748,017	Applicant(s) GANGULY ET AL.	
	Examiner Jagadishwar R. Samala	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/25/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 17-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>03/29/04 & 05/20/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of group I, claims 1-12 and 17-32 in the reply filed on April 25, 2007 is acknowledged. The traversal is on the ground(s) that examining a cosmetic composition containing nacreous pigment and the methods containing measurements and visual observation does not present the examiner with a search burden. This is not found persuasive because group I are drawn to cosmetic composition and group II are drawn method of measuring and visual observation of cosmetic properties differ in scope as indicated by their distinct modes of operation. As such, claims 13-16 and 33-38 are withdrawn for further consideration pursuant to 37 CFR 1.142 (b), as being drawn to a nonelected species and invention, there being no allowable generic or linking claims. The requirement is still deemed proper and is therefore made FINAL.

Claim Disposition

2. Claims 1-12 and 17-32 are pending and are under examination. Nonelected claims 13-16 and 33-38 are withdrawn from consideration and will be rejoined if the group I is found to be a allowable subject matter.

Information Disclosure Statement

3. The Information Disclosure Statement (IDS) filed on march 29, 2004 and may 20, 2005 has been received and entered. The references cited on the PTO-1449 Form have been considered by the examiner and a copy is attached to the instant Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 and 17-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the recitation of "a nacreous pigment having a coated synthetic mica" is indefinite. The meets and bound of this recitation are not clear, since this would encompass a nacreous pigment coated with synthetic mica or synthetic mica is coated with nacreous pigment. Since this definition provides no clear structure, but only is defined by property (i.e. comprising a nacreous pigment having a coated synthetic mica), the scope of this recitation cannot be ascertained. A material defined solely in terms of a property does not particularly point out. See *Ex parte pulvari* (POBA 1966) 157 USPQd 169.

Claims 4-6 and 9-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "gloss of at least" 40%, 60% and 80% in claims 4-6 and "whiteness of at least" 70% and 80% are relative term which renders the claims indefinite. The term "gloss of at least and whiteness of at least" is not defined by the claims, the specification

Art Unit: 1618

does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-12 and 23, 24 and 26-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Fu (US 6,056,815)

Fu discloses a cosmetic composition comprising natural or synthetic mica such as muscovite, phlogopite, and biotite coated with nacreous pigment titanium dioxide having particle size of 5-400 microns (see column 2, lines 41-65+ and claim 12). The titanium dioxide layer is preferably about 50 nm to about 300 nm thickness to provide various colors from whit to yellow, to red, to blur and finally to green. Fu also discloses a promising area of application for cosmetic products in areas such as cosmetics, foodstuffs and food contact applications and thereof (see column 4, lines 46-50).

Since the essential elements of the Fu cosmetic composition are identical to the instant composition (i.e. nacreous pigment, synthetic mica and particle size), the composition would inherently have the same physiochemical properties such as gloss, whiteness, compressibility, transparency, and brightness as the composition set forth in the instant application. (All these properties are inherent and vary with the composition

Art Unit: 1618

of nacreous pigment e.g. see Defossez et al. US 5,486,354; Kimura et al. US 4,623,396). Thus the claims are readily envisaged by the teaching of the cited reference and the claims are properly included in the rejection.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-12, 23, 24 and 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu (US 6,056,815) in view of Calello et al (US 6,033,650).

Fu discloses a composition comprising natural or synthetic mica substrate coating with nacreous pigments, such as titanium dioxide which results in stronger luster and color effects, and its higher stability in indoor weathering (see abstract).

Fu fails to specifically disclose composition wherein the coated synthetic mica has the inherent property of a gloss of at least 40-80% therein. However a cosmetic composition with gloss and shine having improved transfer resistance is well known in the art as shown by Calello.

Calello discloses a cosmetic composition, particularly a lipstick, with long lasting adherence to skin and which also has gloss and shine (see column 2, lines 3-5).

It would have been obvious to one of ordinary skill in the art to modify the composition comprising natural or synthetic mica substrate coating with nacreous pigments, disclosed by Fu to formulate a composition which yields a film which exhibits high gloss high shine cosmetics because Calello teaches that the incorporation of ingredients to improve gloss as three out of every five women prefer lipsticks which are glossy because they provide a dewy look which is associated with youthfulness and good health.

Because the cosmetic compositions with high gloss high shine have excellent long lasting adherence to the skin, or superior transfer resistance, one of ordinary skill in the art would have been motivated to incorporate active ingredients in the composition advanced by Fu. Based on the teaching of Calello, there is reasonable expectation that the cosmetic composition with high gloss, which yields a film, which exhibits, reduced permeability to oil and water would be highly desirable compositions in cosmetic industry. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make use of pigmented cosmetic compositions such as makeup, blush, lipstick and eye shadow, are used to color the skin and lips and at the

Art Unit: 1618

same time provide high gloss of composition advanced by Fu in view of the composition taught by Calello.

10. Claims 1-12,17,18,23,24 and 26- 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu (US 6,056,815) in view of Watanabe et al. (US 4,435,220).

Fu discloses a composition comprising natural or synthetic mica substrate coating with nacreous pigments, such as titanium dioxide which results in stronger luster and color effects, and its higher stability in indoor weathering (see abstract).

Fu fails to disclose composition wherein the coated synthetic mica having an increased transparency of at least 10-15% therein. However a cosmetic composition with excellent transparency, dispersibility, gloss, color, is well known in the art as shown by Watanabe.

Watanabe discloses a cosmetic composition comprising transparent, colored pigments based on platelet-shaped transparent substrate mica such as for example, muscovite, sericite or phlogopite coated with colored metal oxides (see abstract).

It would have been obvious to one of ordinary skill in the art to modify the composition disclosed by Fu to provide a colored pigment with improved transparency, better gloss, a clear color and improved stability because Watanabe teaches that cosmetic composition containing one or more inorganic or organic particulates or colorants may provide transparent pigments of various colors having good transparency.

The cosmetic composition thus obtained have excellent transparency, dispersibility, gloss, clarity of color and stability to heat, and can be used for any of the numerous conventional applications, in particular in cosmetics, one of ordinary skill in the art would have been motivated to incorporate transparent colored pigment in the composition advanced by Fu. Based on the teaching of Watanabe, there is reasonable expectation that the composition with good transparency, which improves the appearance of skin imperfections, dispersibility, gloss, color power and stability to heat would be highly desirable composition in cosmetic field. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make use of transparent colored pigmented cosmetic compositions to improve the appearance of skin imperfections, and at the same time provide good transparency of composition advanced by Fu in view of the composition taught by Watanabe.

12. Claims 1, 18, 19 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu (US 6,056,815) in view of Kimura et al (US 4,623,396).

Fu discloses a composition comprising natural or synthetic mica substrate coating with nacreous pigments, such as titanium dioxide which results in stronger luster and color effects, and its higher stability in indoor weathering (see abstract).

Fu fails to disclose composition wherein the coated synthetic mica having an increased brightness of at least 3-5% therein. However a cosmetic composition with excellent chroma and brightness, dispersibility, color segregation, and foreign odor generation after the formulation, is well known in the art as shown by Kimura.

Kimura discloses a cosmetic composition comprising mica coated with titanium oxide. This mica composite material exhibits excellent color tone (e.g. chroma and brightness), good consistency of an appearance color and an interference color, excellent stability, safety, light and heat resistance (see abstract)

It would have been obvious to one of ordinary skill in the art to modify the composition disclosed by Fu to provide a titanium-mica composite material having an extremely improved color tone (e.g. chroma and brightness), because Kimura teaches that composite material having bright appearance color in agreement with the interference color will have advantageous effects such as pearl gloss, which exhibits the same color as the appearance color thereof when applied to the skin, long term stability without causing color fading, discoloration, and foreign odor generation and excellent dispersion stability without causing color segregation and color shading (see column 6, lines 45-55).

The cosmetic composition thus obtained have excellent chroma and brightness, good consistency of appearance color and interference color, one of ordinary skill in the art would have been motivated to incorporate color tone pigments in the composition disclosed by Fu. Based on the teaching of Kimura, there is reasonable expectation that the composition with good brightness and good consistency of appearance color and interference color can be advantageously used in various fields, including cosmetic industry, daily necessities, and ornaments. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make use of Kimura cosmetic compositions to improve the appearance of skin imperfections, and at the

Art Unit: 1618

same time provide good brightness of composition advanced by Fu in view of the composition taught by kimura.

13. Claims 1,21,22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu (US 6,056,815) in view of Miyoshi et al. (US 5,968,531).

Fu discloses a composition comprising natural or synthetic mica substrate coating with nacreous pigments, such as titanium dioxide which results in stronger luster and color effects, and its higher stability in indoor weathering (see abstract).

Fu fails to disclose composition wherein the synthetic mica is fluorphlogopite. However a cosmetic composition relating to compressed powder cosmetics effective in protecting the skin against ultraviolet rays is well known in the art as shown by Miyoshi.

Miyoshi discloses a composite powder based on substrate particles such as synthetic fluorphlogopite mica coated with micronized metal oxides particles (see column 3, lines 12-15).

It would have been obvious to one of ordinary skill in the art to modify the composition disclosed by Fu to include synthetic fluorphlogopite mica as substrate particle because Miyoshi teaches that the incorporation of synthetic fluorphlogopite mica coated with micronized metal oxides particles such as titanium dioxide provides a cosmetic composition effective in protecting the skin against ultraviolet rays.

Because the cosmetic composition having ability to protect the skin against ultraviolet rays and have excellent long lasting adherence to the skin, one of ordinary skill in the art would have been motivated to incorporate synthetic fluorphlogopite mica

Art Unit: 1618

coated with micronized metal oxides particles in the composition advanced by Fu.

Based on the teaching of Miyoshi, there is reasonable expectation that the cosmetic composition having excellent long lasting adherence to skin and protect from ultraviolet rays would be highly desirable composition in cosmetic field. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make use of synthetic fluorphlogopite mica coated with micronized metal oxides composition which has a smooth, lubricious and pleasant feel on the skin and retains its transparency advanced by Fu in view of the composition advanced by Miyoshi.

Conclusion

1. No claims are allowed at this time.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagadishwar R. Samala whose telephone number is (571)272-9927. The examiner can normally be reached on 8.30 A.M to 5.00 P.M.

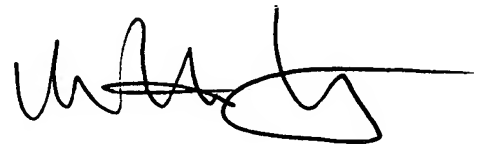
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571)272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1618

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jagadishwar R Samala
Examiner
Art Unit 1618

sjr

A handwritten signature in black ink, appearing to read 'Michael G. Hartley', with a stylized, sweeping underline.

MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER